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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,144	08/23/2001	Robert Barry Wood	STL9833/40046.150USU1	1721
23552	7590	11/28/2003	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			MAI, RIJUE	
			ART UNIT	PAPER NUMBER
			2182	
DATE MAILED: 11/28/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/938,144

Applicant(s)
Wood

Examiner
Rijue Mai

Art Unit
2182



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Aug 23, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Claims 1-15 are presented for examination.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, and 13-15, drawn to input/output application specific peripheral adapting, classified in class 710, subclass 72.
 - II. Claims 10-12, drawn to concurrent input/output processing and data transfer, classified in class 710, subclass 20.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a disk drive running an operating system including an application program, and the disk drive is connected to a communication network, invention II has separate utility such as the intelligent storage element enables improved portability personalized application data. See MPEP § 806.05(d).

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr John Wahl On October 30, 2003, a provisional election was made without traverse to prosecute the invention of group I , claims 1-9 and 13-15, therefore claims 10-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. The inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published

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under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1-2, 5-7, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al. US pat.6476995 (hereinafter Liu) .

As per claims 1, 7, and 13, Liu teaches a data storage device in a form factor assembly not greater than three and one half inches (see Fig 1, 4, a factory standard disk drive), comprising: a data disc rotatably mounted on a baseplate (see col 6, lines 10-12); an actuator arm adjacent to the data disc carrying a transducer for reading data from and writing data to the data disc (see col 6, lines 12-27, col 9, lines 1-13, col 13, lines 21-33); a printed circuit board fastened to the baseplate having a servo controller in operable communication with the actuator arm for moving the actuator arm over the data disc (see col 6, lines 49-67, col 7, lines 63-67); a CPU connected to the PCB generating control signals to the servo controller and running an operating system (see col 8, lines 56-60, col 13, lines 51-58, Fig 3); and memory storing an application program operably connected to the CPU, whereby the application program is run by the CPU (see col 8, lines 40-49, Fig 3).

Referring to claims 2, 5-6, Liu further teaches data storage device, wherein the data storage device is connected to a communication network, an input/output module communicating to a node connected to the communication network (see col 8, lines 49-53, Fig 3); data storage

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device is a three and one half inches form factor assembly (see Fig 1, factory standard assembly); a file system managing file data stored on the data disc, wherein the file system is in direct communication with the servo controller (see col 8, lines 1-9).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-4, 8-9, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. in view of Gronemeyer et al. US pat. 6363359 (hereinafter Gronemeyer) .

As per claims 3-4, 8-9 and 14-15, Liu does not specifically teach the I/O module includes “ a network interface module operable to communicate to a node on the network using a hypertext transport protocol and a video interface module operable to drive a video monitor” as claimed.

Gronemeyer teaches system for facilitating e-commerce transaction between a client and a server over a network, wherein the computing device includes network application protocol such as HTTP and a video interface for presenting output to an output device, I/O interface port for communication with input devices and a network interface (see col 8, lines 45-51, col 9, lines 1-20, Fig 4).

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It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow Liu's system to make use of Gronemeyer's teachings and determine the need for the network using a hypertext transport protocol and a video interface module or any peripheral devices accordingly, because it provides other communication with the input/output module to transmit data to and receive data from the external devices, thereby enhance the system operation and performance . Furthermore, it also provides greater needs for the user, thus the system can be more easily cope with changes in user request. This procedure provides a precise data processing function that can be discretely adjusted to greatly reduce the amount of processing timing in the computer system.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rijue Mai** whose telephone number is (703) 308-7098

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The examiner can normally be reached on Monday-Thursday from 7:00 AM to 4:30 PM, and alternate Friday Eastern Time. The examiner can also be E-mailed at

Mai.Rijue@uspto.gov.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeffrey Gaffin, can be reached on (703) 308-3301.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Assistant Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

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Or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 746-7240, (for informal or draft communications, please label

“PROPOSED” or “DRAFT”)

EXAMINER

Rijue Mai

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November 17, 2003



Rehana Perveen
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